

REMARKS

Reconsideration of the application, as amended, is respectfully requested in view of the following remarks.

In connection with the §112 rejection, the Office points to ranges for added non-peanut protein which include 2-5% and 3-8%. The Office then complains that “no criticality” has been established to 3-15% with regard to the range end points. However, the Office points to no authority requiring “criticality” of the end points of a range in order to satisfy the written description requirement. The Office asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the invention was filed had possession of the claimed invention. Given that the Office acknowledges the range of 2-15% and another range having a literal end point of 3%, it is submitted that one of ordinary skill would very well appreciate that the range of 3-15% was within the possession of the applicants as their claimed invention. Consequently, it is respectfully requested that the rejection be withdrawn.

The dependency of claims 13 and 22 have been corrected in response to the informality rejection by the Office.

In KSR International Co. v. Teleflex Inc. (US April 30, 2007) the Supreme Court stated “rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. As our precedents make clear, however, the analysis need not seek out the precise teachings directed to the

specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. As the Supreme Court said in KSR, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. In KSR, the Court indicated that one of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims. But the Court also pointed out that a fact finder should be aware of the distortion caused by hindsight bias and must be cautious of arguments relying upon *ex post* reasoning.

Billerbeck et al. are concerned with peanut butter having a sweetening agent and a way of preparing it. An exemplary sweetening agent is said to be honey. It is said that other sweetening agents may be employed including those which are naturally occurring, naturally derived or which contain synthetic groups. However, illustrative sweetening agents are said to include corn syrup, sweetose, liquid sugar, maple syrup, etc. It would hardly seem that reduction of carbohydrates is an important concern of Billerbeck et al. Nor do Billerbeck et al appear to teach how to formulate such a product; the examples include cerelese and honey.

In contrast to Billerbeck et al., Sevenants et al. seem concerned primarily about reducing the fat content of peanut butter or peanut spreads. Although artificial

sweeteners are mentioned, the Office points to no teaching of what other characteristics an artificially sweetened Sevenants et al. composition would have. For example, Example 1 includes sugar and corn syrup solids and does not include an artificial sweetener.

The Office argues that it would have been obvious to modify Billerbeck et al. and add non-peanut solids to reduce fat content as taught by Sevanants et al. However, the Office does not point to a teaching by Sevanants et al. as to the overall composition of artificial sweetener containing products specifically or that non-peanut protein solids could be added to offset any natural sweeteners which have been eliminated. Moreover, since Billerbeck et al. seem concerned with improved flavor, composition, appearance and shelf characteristics of sweetened peanut butter (abstract; col. 1, first two paragraphs), it seems unlikely that one of ordinary skill would combine it with Sevanants et al. to lower its sugar and its fats in the way suggested by the Office.

It is therefore submitted, that one of ordinary skill having only the Billerbeck et al. and Sevanants et al. references in front of him or her, without the benefit of the teaching of the present specification, cannot fairly be said to be led to the presently claimed, low carbohydrate peanut spreads.

In view of the foregoing, it is respectfully requested that the application, as amended, be allowed.

Respectfully submitted,



Gerard J. McGowan, Jr.
Registration No. 29,412
Attorney for Applicant(s)

GJM/mpk
(201) 894-2297